

Appl. No. 10/642,413
Reply to 01/06/04 Non-Final Office Action

Law Office of Duncan Palmatier
Atty Dkt: Huang/Raised Portion

REMARKS

I. REJECTION OF CLAIMS 1 AND 12 UNDER 35 USC §102(b)

A. TAN DOES NOT HAVE THE ELEMENTS RECITED BY THE EXAMINER

1. Tan's Audio Jack (17) Mating Ports (29) Are Not Raised Portions With Background and Design Surfaces

The Examiner rejected the two independent claims, 1 and 12, under 35 U.S.C. §102(b), as being anticipated by U.S. Patent No. 5,735,699 to Tan ("Tan"). See January 6, 2004 Non-Final Office Action ("1/6/04 OA"), at p. 2. Of particular importance, the Examiner erroneously interpreted the drawings as showing the Applicant's claimed "raised portion" with a "background surface" and "design surface", when, in fact, Tan shows and describes an audio jack unit (17) with a hollow, cylindrical "mating port" (29) for receiving an audio jack connector, but no surfaces. Thus, Tan does not show the elements of Applicant's claims.

Tan discloses an "existing universal frame and its associated audio jack assembly" (12) (see Tan, at Col. 1:37-38), "for mounting to a mother board (100)" (id., Abstract) within a "computer case" (id., at Col. 1:10-11), with an improved grounding clip (26). Id., at Col. 1:6 and 1:35). The Examiner misunderstands the structure of the audio jack (16) mating ports (29) (id., at Col. 3:46) and argues that they constitute the "raised portion" element of the claims at issue. See 1/6/04 OA,

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at 2. The Examiner mistakenly speculates that each of the audio jack mating ports (29) of Tan "further comprises a **background surface BS** and a **design surface DS**, and the design surface is formed as part of the background surface and is not level with the background surface". Id. (Emphasis added.) Tan does not disclose or show such a structure. On the contrary, Tan discloses a "three-in-one integral audio jack assembly 16" (see Tan, at Col. 2:28) "composed of three audio jack units 17" (id., at Col. 2:38-39) having electrical contacts (22 and 24, id., at Col. 2:40-41) for mating to a computer motherboard (100, id., at Col. 2:41-51), and each audio jack unit (17) has a "mating port" (29, id., at Col. 3:46):

the mating port 29 of the audio jack unit 17 commonly project out of the opening 48 of the bracket 12 wherein the mating portion 29 of the audio jack unit 17 is positioned on the upper portion thereof...

See Tan, at Col. 3:45-49. The expressly referenced companion application of Tan (see Tan, at Col. 1:13-14), U.S. Patent No. 5,643,008 ("Tan II"), includes a slightly more detailed description of the audio jack assembly and mating ports:

the mating portion 42 of each unit 34 of the audio jack assembly 30 is adapted to project out of the corresponding opening 25 of the bracket 12 for coupling to the complementary cable connector (not shown).

See Tan II, at Col. 3:51-55.

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From these teachings of Tan, it will be appreciated that, contrary to the Examiner's erroneous speculation, Tan does not show any surface, neither background nor design, neither "exposed", level nor lower than any other surface; rather, Tan shows a hollow, cylindrical audio jack mating port (29) to receive an audio cable connector. Therefore, as to the background and design surface elements, Tan does not anticipate the claimed structure.

Moreover, as described in Tan and Tan II, each audio jack unit (17) has four signal contacts (22) as well as a grounding contact (24) (see Tan, at Col. 2:38-41, and Tan II, at Col. 3:26-32), and it will be appreciated that the mating ports (29) are formed in multiple rings of electrical contacts and insulators. The claim language at issue here includes the limitation that the raised portion "is formed as part of the background surface", which is not taught by the many-layered audio jack ports of Tan.

2. Tan Lacks The Other Claimed Elements And Limitations

The Examiner also misinterpreted the other elements of Tan. The structure shown in Tan is an audio jack assembly (10), with a grounding clip (26), for mounting to a computer motherboard (100). This structure does not disclose or teach the elements of Applicant's claims, such as a "housing with an outer surface", an "end adapted to hold an electrical connector plug", a "raised

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portion", etc.

The Examiner argues that the "three-in-one integral audio jack assembly 16" of Tan (see Tan, at Col. 2:28) is the equivalent of the claimed "housing". See 1/6/04 OA, at p. 2. This is incorrect. As explained in Tan, the three-in-one integral audio jack "assembly" (16) is an assembly, that is, a collection of parts (see Tan, at Col. 2:38-51), and does not form a "housing" at all. The Examiner does not point out what part of Tan's three-in-one integral audio jack assembly (16) constitutes the claims' "outer surface", and erroneously associates a "downward huge cavity 20" (id., at Col. 2:33-34) in the "universal frame or bracket 12" (id., at Col. 2:25) with the three-in-one integral audio jack assembly (16). See 1/6/04 OA, at p. 2. The cavity (20) of Tan is in its bracket (20), not in the three-in-one integral audio jack assembly (16), and is not an "end adapted to hold an electrical connector plug", as claimed. The audio jack mating ports (29) of Tan are not the claimed "raised portion"; rather, they are themselves audio jack connectors. The Examiner incorrectly interprets the "universal frame or bracket 12" (id., at Col. 2:25) of Tan with the claimed "covering formed over the outer surface of the housing". See 1/6/04 OA, at p. 2. As Tan describes, the bracket (12) is a frame to hold a D-subminiature connector (14), not a covering.

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See Tan, at Col. 2:25-31 (the connector (14) is attached to the bracket (12) by rivets (18)). Tan nowhere teaches a covering as claimed here. Thus, Tan does not have any of the elements at issue here.

B. OWENS CANNOT ANTICIPATE THE CLAIMED INVENTION BECAUSE IT LACKS ALL THE ELEMENTS AND LIMITATIONS

The Examiner also argues that the claims are anticipated by U.S. Patent No. 4,704,091 to Owens, et al. ("Owens"). See 01/806/04 OA, at p. 3. This anticipation argument is improper, because the Examiner admits that Owens fails to teach the background and design surface elements, as well as other limitations of Applicant's claims. See 1/6/04 OA, at p. 3. A rejection for anticipation under Section 102 requires that each and every limitation of the claimed invention be disclosed in a single prior art reference. In re Spada, 911 F.2d 705, 708, 15 U.S.P.Q.2d 1655, 1657 (Fed. Cir. 1990). In addition, the reference must be enabling and describe the applicant's claimed invention sufficiently to have placed it in possession of a person of ordinary skill in the field of the invention. Id.

The Examiner incorrectly cites In re Seid, 161 F.2d 229 (C.C.P.A. 1947), for the proposition that claim elements or limitations relating to "ornamentation only" do not fall within the general rule that a single anticipating reference must disclose every claimed element. See 1/6/04 OA, at p. 3. In re

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Seid did not involve anticipation; rather, it addressed the issue of obviousness.

It was conceded by both the board and the examiner that the claims were not met by any single reference.

The issue presented here is whether the proposed combination of references is an **obvious** one or one involving invention.

Id., 161 F.2d at 231 (emphasis added).

Moreover, the Examiner misinterpreted the ruling in In re Seid. In that case, the claim at issue involved a soda bottle with "an artificial display figure... representing exteriorly a human head and upper body trunk", of a specifically claimed form, to fit over the bottle's neck. Id., 161 F.2d at 229-30. The claim was rejected as obvious in light of several prior art patents disclosing bottles with neck coverings and human figures. Id., 161 F.2d at 230. The Court held that the "particular shape and arrangement" of the applicant's claimed human figure, "including the arrangement of the arms", related "to ornamentation only and have no mechanical function whatsoever." Id., 161 F.2d at 231. It should be noted that all of the issued prior art patents discussed in In re Seid included claims for structures intended to provide a place for a design - ornamentation - on bottles. The applicant's difficulty in In re Seid was that the claimed bottle design was only distinguishable to the extent it recited a *specific design* of a human form.

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Thus, In re Seid stands for the rule that a claim reciting a specific ornamental design, such as a human figure arranged in a particular way, cannot be distinguished from prior art that discloses a generic design, such as a human figure.

In this application, the Examiner argues that, since the claims relate to a structure with background surface and a design surface, they claim "matters relating to **ornamentation only which have no mechanical function**" and are unpatentable. See 1/6/04 OA, at p. 3 (emphasis in original). The Examiner has confused mechanical structure having the function of providing a place for ornamentation with the ornamentation itself. In the present application, Applicant has made no claim to a particular ornamentation; rather, Applicant has claimed a mechanical structure, with expressly detailed industrial advantages, that can provide a "design surface" of a certain type. Thus, In re Seid does not support the Examiner's rejection. Moreover, all the prior art cited in In re Seid involved issued patents that claimed structures for locating ornamental designs, which is the case in the present application.

Finally, the mechanical advantages of the present design have been expressly recited in Applicant's Specification. See Specification, "Discussion of Prior Art", at pp. 1-3. The problem of a two-step molding process to apply manufacturers' designs is expressly described. Id., at p. 2:13-23. The problem

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of distinguishing a manufacturer's design through transparent plastic is also described. Id., at p. 2:25-3:5. The present invention provides a mechanical structure for an electrical connector that overcomes these problems. The specific form of an ornamental design is not claimed. Therefore, the Examiner's reliance on In re Seid is misplaced.

II. REJECTION OF CLAIMS 1, 3, 4-10, 11, AND 14-16 UNDER 35 USC §103(a)

The Examiner rejected dependent claims 3, 4-7, 11 and 14-16 under 35 U.S.C. §103(a) as being unpatentable over Owens. See 1/6/04 OA, at pp. 4-5.

The Examiner argues that Owens renders claims 3, 14 (sub-surface limitation), 7 and 15 (above-surface limitation) obvious, because "applicant has not disclosed that this limitation solve [sic] any stated problem or are for any other purpose". Id. The Examiner is mistaken. As noted above, Applicant's Specification describes the problems of the prior art, including the multi-step molding and transparent plastic covering problems (see, Specification, at pp. 2:13-3:5), and explains that the claimed invention overcomes these problems by providing a design surface in which and onto which "logos or other information can be placed on or molded into". Id., "Summary of the Invention", at p. 3:21-22. The Specification explains that according to the claimed structure, "a cable connector or adapter can be manufactured and

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assembled with fewer parts and steps, and the finished product will provide a superior surface for logos and information." Id., at p. 4:1-4. Therefore, contrary to the Examiner's argument, Applicant fully described the problems of the prior art and how the claimed structure overcomes those problems.

The Examiner argues that Owens renders claims 4 through 6 (sub-surface limitation) and 8 through 10 (above-surface limitation) obvious, because these claims recite an unpatentable product by process when the "method does not impart any structural limitation." See 1/6/04 OA, at p. 4 and at p. 5. The Examiner argues that Owens is the primary reference, relying on the 35 USC §102(b) rejection of the base claims, discussed above. As explained above, Owens does not anticipate the base claims. Therefore, the rejection of these dependent claims fails. Moreover, contrary to the Examiner's argument, the rejected claims are distinguishable over the prior art, because they claim structures that overcome the problems of the prior art; namely, providing a design surface in which and onto which "logos or other information can be placed on or molded into" (see, Specification, at p. 3:21-22), to overcome the multi-step molding and transparent plastic covering problems. Id., at pp. 2:13-3:5). The Specification also explains that the claimed structure can provide a cable connector that "can be manufactured and assembled with fewer parts and steps", and a finished product

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with "a superior surface for logos and information." Id., at p. 4:1-4. Thus, the claimed structure and process for manufacturing that structure have expressly described advantages over the prior art.

The Examiner rejected dependent claims 11 and 16 as unpatentable over Owens in view of U.S. Patent No. 4,164,725 to Wiebe ("Wiebe"). See 1/6/04 OA, at p. 5. The Examiner argues that Owens is the primary reference, relying on the 35 USC §102(b) rejection of the base claims, discussed above. As explained above, Owens does not anticipate the base claims. Therefore, the rejection of these dependent claims fails.

To establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant. In re Werner Kotzab, 217 F.3d 1365, 1370 55 U.S.P.Q.2d (BNA) 1313 (Fed. Cir. 2000) (internal citations omitted). The Examiner cited no suggestion or motivation to combine Owens with Wiebe. Rather, the Examiner improperly cited the desirability of providing a gripping surface (see 1/6/04 OA, at p. 5: "to permit one to better grip the connector") as the motivation to combine the references. This type of circular argument cannot form the basis of an obviousness rejection.

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III. OTHER CITED ART

The Examiner generally cited several patents and publications as "pertinent". See 1/6/04 OA, at p. 6. As to U.S. Publication No. 10/326,177 ("Fung"), it was filed on December 19, 2002, long after the effective filing date of this continuation application (September 8, 2000). As to Patent Nos. 5,863,210 to Reisinger ("Reisinger"), and 6,296,526 to Yarbrough ("Yarbrough", the Examiner does not indicate whether these references are anticipating or render the claimed invention obvious, nor does the Examiner address what elements disclosed in those references relate to the pending claims. Therefore, Applicant is unable to discern how or why these references affect the present application and the Examiner's reliance on them is improper. The Examiner cited U.S. Design Patent No. Des. 208,147 to Clayton ("Clayton") for the design on the "knob". Clayton relates to knobs, such as knobs for cabinets. It has no relevance to the instant application. The Examiner has made no attempt to point out any suggestion or motivation to combine Clayton with any reference, and there is no relevance to the knob design of Clayton to the electrical connector structure of the present invention. The Examiner cites U.S. Patent No. 4,202,351 to Biche ("Biche"), which relates to an "identification means for the ends of lead wires of electrocardiographic monitoring instruments". See Biche, at Col. 1:7-9. Biche does not relate to electrical

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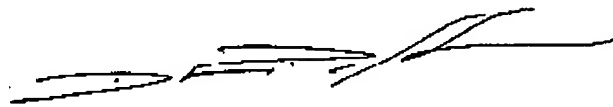
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connectors, as involved in the present application; rather, Biche relates to medical instruments. Id. The "identification means" disclosed in Biche is an "identification cap 42". Id., at Col. 6:26. Biche does not have any of the elements at issue in the claims here, such as an electrical connector, a housing, an outer surface, an end to hold an electrical connector plug, a raised portion, a covering, an exposed part of the raised portion, etc. The Examiner has made no attempt to explain how Biche could be relevant to the present application, nor has the Examiner made any attempt to combine Biche with any other reference.

IV. CONCLUSION

For the reasons set forth above, the Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

Respectfully submitted,



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